Claim 10 was rejected under 35 U.S.C. §101 as being directed towards non-statutory subject matter. This rejection is respectfully traversed.

A carrier wave is a physical, computer readable medium capable of transmitting a computer program and causing a computer to execute the computer program, just as a floppy disk is capable of causing a computer to execute a computer program contained on the floppy disk. A carrier wave embodiment is not a mere program listing, and, therefore, is not descriptive material. The preamble "a computer program embodied on a carrier wave" is an article of manufacture form suggested and endorsed by the U.S. Patent and Trademark Office ("PTO"). Recent training material used by the PTO have been employed to convey this new article of manufacture to the Examining corps. Because the preamble language is sanctioned by the PTO, the Examiner's rejection under 35 U.S.C. §101 is not valid as the Examiner, a member of an administrative agency, is bound to follow the guidelines established by such administrative agency. Reconsideration and withdrawal of the rejection of claim 10 under 35 U.S.C. §101 are respectfully requested.

Claims 1 through 11 were rejected under 35 U.S.C. §103 for obviousness predicated upon Walker et al. (PCT Application WO 97/22073) in view of Titan (U.S. Pat. No. 5,745,654) and further in view of Norris (U.S. Pat. No. 5,940,811). This rejection is respectfully traversed.

Applicants submit that the Patent and Trademark Office (PTO) did not establish a prima facie case of obviousness under 35 U.S.C. §103 by failing to include all claim limitations and by failing to establish the requisite realistic motivation.

The Claimed Invention

The claimed invention is directed to a method and apparatus for evaluating the reason for rejecting a credit card applicant and supplying an appropriate reason for such rejection to the applicant. An automated method and/or system according to the present invention requires no human interaction in order to determine and communicate the reason why an applicant was not extended a line of credit. Claim 1 recites a method of presenting a reason for the rejection of a credit application from an applicant comprising:

> "obtaining a factor from a credit bureau identified as influencing the FICO score assigned to the application by the credit bureau;
> mapping the factor identified by the credit bureau to an internal rejection code;
> providing a rejection reason corresponding to the internal rejection code to the applicant."

One of the problems overcome by the present invention is how to automate determining and displaying rejection reasons to a credit applicant. The present invention overcomes the hurdle of automatically presenting rejection reasons to an applicant by, **inter alia**, mapping factors identified by a credit bureau to internal rejection codes, which are to be displayed to a credit applicant who does not qualify for credit.

Walker et al. Does Not Disclose Presenting a Reason for the Rejection of a Credit Application

The Examiner has interpreted Walker et al. beyond the teachings of Walker et al. in order to reject claims 1 through 11. Simply stated, Walker et al. does not teach, disclose, or suggest what the Examiner alleges Walker et al. teaches, discloses, or suggests.

The Examiner asserts that Walker et al. "discloses a method of presenting a reason for the rejection of a credit application from an applicant ..." when Walker et al. clearly does not disclose, nor even suggest, "a method of presenting a reason for the rejection of a credit application." In fact, the portions of Walker et al. that the Examiner points to as verification that

Walker et al. discloses a method of presenting a reason for the rejection of a credit application are concerned with ***conditional approvals***, and not with rejections - let alone the reasons for rejections. The Examiner has been unable to point out where in Walker et al. a disclosure of a method of presenting a reason for the rejection of a credit application is made because no such disclosure exists in Walker et al.

The only places where Walker et al. discusses rejections of credit applicants are on page 21, lines 3-5, where Walker et al. makes clear that when a credit applicant is turned down information is sent to the bankcard acquisition system so that a decline letter may be issued; and on page 22, lines 5-9, where Walker et al. describes a switch from a credit qualified mode to a credit request mode that identifies appropriate adverse action reasons, as is done for a standard credit request. On page 11, Walker et al. discloses that adverse action reasons for a standard credit request, i.e., rankings, are used to inform the local branch representative ("LBR") how to converse with the applicant, and for back office processing to effect an immediate booking or immediate adverse action.

Because Walker et al. does not disclose "presenting a reason for the rejection of a credit application" as claimed in claim 1, Walker et al. cannot be used to support a rejection of claim 1 under 35 U.S.C. §103(a). Walker et al. does not address the problem addressed and solved by the present invention. The problem addressed and solved by the claimed invention must be considered when resolving the legal conclusion of obviousness under 35 U.S.C. § 103. **Jones v. Hardy**, 727 F.2d 1524, 220 USPQ 1021 (Fed. Cir. 1984). Without an existing basis in Walker et al., the conclusion is inescapable that impermissible hindsight was used to "find" presenting a reason for the rejection of a credit application as part of the disclosure of Walker et al. Based

upon the foregoing, reconsideration and withdrawal of the rejection of claim 1 are respectfully requested.

Walker et al. Does Not Disclose Mapping the Factor to a Rejection Code

Walker et al. does not disclose, teach or suggest "mapping the factor identified by the credit bureau information [sic] to an internal rejection code" as asserted by the Examiner; and as claimed in claim 1. To support the allegation that Walker et al. discloses mapping as recited in claim 1, the Examiner points to page 10, line 25 - page 11, line 4, which reads:

"All established product program requirements (front-end screens, disaster screens, credit score, debt burden), as well as consideration of a new or existing customer's deposit balance, are systematically completed and ***ranked*** (A, B, C, D) within a matter of seconds. This enables the LBR 12 to immediately convey credit evaluation status (recommended approval, conditional approval, upsell, counter-offer, recommended turndown) to the applicant 10. The A, B, C, D ***status rankings*** *indicate to the LBR 12 the direction to take during the sales session* (i.e., the systematically provided rankings identify high and low credit risks). For purposes of expeditious back office processing, block 44, these ***rankings*** also delineate which requests for credit may be processed for immediate appeal, resulting in an immediate booking or an immediate adverse action." (emphasis added)

The passage pointed to by the Examiner shows that Walker et al. ranks program requirements into an order where A is the first ranking level, B is the next ranking level, followed by C and D respectively. In other words, the requirements are placed in a preferential order; they are ***not*** mapped to an internal rejection code as recited in claim 1. In fact, no mention of rejection codes is made by Walker et al., nor are the ranking levels (A, B, C, D) indicative of a rejection of a credit applicant. The passage cited by the Examiner clearly states that the ranking levels (A, B, C, D) "identify high and low credit risks" and also makes clear that the ranking levels (A, B, C, D) do not indicate that an applicant has been rejected. The passage further clarifies that the ranking order of the requirements is used by the LBR to assist the LBR in

guiding further discussions with the applicant; and that the rankings are used to speed the back office processing.

The Examiner also points to pages 12 and 13 as evidence that Walker et al. maps factors to internal rejection codes, however, these pages merely explain how the ranking (A, B, C, D) of the requirements is accomplished, and how the rankings are utilized by the LBR. Nowhere on pages 12 and 13 does Walker et al. disclose, teach, or suggest mapping factors to an internal rejection code, in fact, Walker et al. does not even mention outright rejections being made at this point in the processing of an application for credit.

As averred, supra, Walker et al. does not disclose "mapping the factor identified by the credit bureau to an internal rejection code" as recited in claim 1. Because all of the claim limitations recited by claim 1 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal v. Rudkin-Wiley**, 5 USPQ2d 1434 (Fed. Cir. 1988). The rejection of claim 1 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Walker et al. Does Not Disclose a Rejection Based on an Internal Rejection Code

The Examiner alleges that Walker et al. discloses "providing a rejection of the credit application based on an internal rejection code (Grades B-D) corresponding generally to a reason for the rejection (credit score, debt burden, high liability, etc.) to the user of the system." It should be noted that Walker et al. does ***not*** disclose "providing a rejection of the credit application based on an internal rejection code (Grades B-D) corresponding generally to a reason for the rejection (credit score, debt burden, high liability, etc.) to the user of the system" as stated

by the Examiner, nor does Walker et al. disclose "providing a rejection reason corresponding to the internal rejection code to the applicant" as recited in claim 1.

The Grades B-D referred to by the Examiner are not rejection codes, but are rankings of factors such as front-end screens, disaster screens, credit score, debt burden, high liability, etc. - which are the requirements that an applicant must enter via the LBR when applying for credit. See pages 10 - 13 of Walker et al. When an LBR sees the rankings A-D, the LBR is given an indication as to how to handle the rest of the conversation with the credit applicant, i.e., whether to tell the applicant to expect credit approval, or that a review is necessary before a determination of whether to extend credit approval is made, as well as a likely outcome of such a review. Contrary to the Examiner's assertion, Grades B-D indicate that the applicant's information needs to be reviewed, not that the applicant has been rejected. Therefore, Walker et al. does not disclose an "internal rejection code" as recited in claim 1.

The "reasons" for rejection given by the Examiner, i.e., credit score, debt burden, high liability, etc., are actually some of the requirements (others include front-end screens, disaster screens, etc.) that are supplied by the applicant and systematically ranked A through D. The Examiner's "reasons" are not of themselves reasons for rejecting a credit applicant, but are factors that are evaluated and ranked in order to determine whether the applicant's information needs to be reviewed, and what type of review is necessary. Therefore, Walker et al. does not disclose "providing a rejection reason" as recited in claim 1.

Because all of the claim limitations recited by claim 1 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal, supra**. The rejection of claim 1 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Claims 9 through 11

Claims 9 through 11 are not obvious over Walker et al. in view of Titan in further view of Norris for the same reasons articulated in regard to claim 1. The various embodiments claimed in claims 9, 10, and 11 contain limitations similar to those contained in claim 1, therefore, the arguments made with respect to claim 1 apply to claims 9, 10, and 11.

Because all of the claim limitations recited by claims 9-11 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal, supra**. The rejection of claims 9-11 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Claims 2-11 are Not Obvious in View of the Cited Art

Claims 2 through 8 depend directly or indirectly from claim 1, thus containing all of the limitations of claim 1. For at least this reason, claims 2 through 8 are allowable for the reasons articulated supra. The rejection of claims 2 through 8 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Claims 2 and 3

Regarding claims 2 and 3, Walker et al. does not disclose "determining whether the internal rejection code corresponds to a specific code or a general code and performing various tests to determine whether the result corresponds to an appropriate rejection reason, and if so, assigning the appropriate internal rejection code for the specific rejection reason or assigning a general rejection code" as asserted by the Examiner. Additionally, Walker et al. does not disclose "determining whether the internal rejection code corresponds to a specific code or a

general code; if the internal rejection code corresponds to a general code, checking a result of an attribute test to determine whether the result corresponds to an appropriate rejection reason; and if the attribute test result corresponds to an appropriate rejection reason, then changing the internal rejection code to correspond to the appropriate rejection reason" as recited in claim 2.

To support the rejection of claims 2 and 3, the Examiner references Walker et al. page 12, line 1 - page 13, line 3 - which discusses ranking the requirements entered by an LBR for a credit applicant - page 13, lines 9-13 - which discusses how the rank (A, B, C, or D) is determined for a particular credit applicant - page 20, lines 5-10 - which discusses what an LBR does with the results of a credit evaluation, e.g., either open an account or pick the appropriate entitlement or rejection options from among several that are presented on a screen - page 21, lines 1-6 - which discusses "appropriate processing information ... for issuance of decline letters," a feature that the present invention discusses as a back-up for ensuring that a rejected credit applicant is made aware of the rejection and is given proper notice in the event that the applicant did not verify on-line receipt of the rejection - page 22, lines 5-10 - which discusses presenting appropriate adverse action reasons for an LBR to choose from if an applicant does not meet the credit request criteria - page 25, line 20 to page 26, line 13 - which discusses the prescreening process and what happens if an applicant fails a prescreening stage, e.g., the application is routed for review and notification is sent to the LBR that the applicant's application is being reviewed. The Examiner also cites Figures 9-10h - which display the information from the above cited passages in a tabular form - as support.

Nowhere in any of the passages cited by the Examiner, nor anywhere else in Walker et al., is there any reference, teaching, disclosure, or suggestion of "determining whether the internal rejection code corresponds to a specific code or a general code" as recited in claim 2. In

fact, there is no mention of any kind of rejection code, internal or otherwise. Walker et al. does not discuss rejection codes because rejection decisions are made by underwriters or other personnel in the back office who review credit applications with a rank of B, C, or D and then supply appropriate rejection reasons if needed. There is no need for rejection codes in the process disclosed by Walker et al.

Additionally, Walker et al. does not disclose "if the internal rejection code corresponds to a general code, checking a result of an attribute test to determine whether the result corresponds to an appropriate rejection reason" as recited by claim 2. The Examiner has perhaps confused the prescreening process described by Walker et al., which results in a review of an application if a prescreening step is failed, as an attribute test as claimed in claim 2. Unlike a prescreening test, an attribute test according to the present invention is performed on a general internal rejection code in order to determine whether the general internal rejection code has a corresponding, appropriate rejection reason that can be displayed to the applicant instead of the reason associated with the general internal rejection code. It is clear that a prescreening test, e.g., determining whether the applicant is above a minimum age, or has an income above a minimum level, is entirely different from checking general rejection codes for corresponding, appropriate rejection reasons that can be displayed instead of a general rejection reason.

Because all of the claim limitations recited by claims 2 and 3 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal, supra**. The rejection of claims 2 and 3 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Claims 4 and 5

The Examiner is correct in stating that Walker et al. "discloses that a local branch representative typically informs the applicant if the application for credit is rejected." However, the Examiner fails to recognize that Walker et al. also discloses that the LBR is presented with a screen containing rejection reasons. The LBR then chooses the appropriate reasons to communicate to the applicant from among those that are presented on the LBR's screen. See Walker et al., pages 10 through 13. The rejection reasons are presented to the LBR only after the applicant's application has been reviewed by an underwriter or other personnel in the back office who supply the reasons. Because Walker et al. discloses that the underwriter's judgment and the LBR's judgment is necessary in order to present rejection reasons to an applicant, there is no motivation to combine Walker et al. with Norris. Additionally, the Examiner has not even attempted to supply motivation to combine Walker et al. with Norris.

Applicants stress that the PTO is charged with the burden of establishing a basis in the applied prior art that would have realistically motivated one having ordinary skill in the art to modify a specific reference in a specific manner. **In re Duel**, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995). Not only must a realistic motivation exist, but the Examiner must establish that one having ordinary skill in the art would have been realistically motivated with a reasonable expectation of successfully achieving the objectives of the prior art. **In re Vaeck**, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). That burden has not been discharged, hence the combination of Walker et al. with Norris cannot be maintained.

Based upon the foregoing, Applicants respectfully submit that the Examiner has not established a prima facie case of obviousness under 35 U.S.C. § 103 for lack of the requisite motivational element. Moreover, upon giving due consideration to the fact that the art of record

does not disclose most of the claim limitations, the conclusion is inescapable that one having ordinary skill in the art would not have realized the claimed invention as held within the meaning of 35 U.S.C. § 103. **Uniroyal, supra**. The rejection of claims 4 and 5 for obviousness predicated upon Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Claims 6 - 8

Regarding claims 6 and 7, Applicants aver that Walker et al. does not disclose or suggest the material that the Examiner asserts Walker et al. discloses. See arguments, supra. Additionally, the Examiner has made no showing of motivation to combine Walker et al. with Norris as is required by the MPEP and relevant case law. The combination of Walker et al. with Norris is, therefore, not sustainable as there is no motivation to combine Norris with Walker et al.

Because all of the claim limitations recited by claims 6 and 7 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal, supra**. The rejection of claims 6 and 7 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

Regarding claim 8, in addition to Walker et al. failing to disclose the claimed limitations of claim 1, neither Norris nor Zandi teach or suggest "an applet that communicates automatically that the web page has been downloaded." Zandi, although disclosing a web based loan auctioning system, does not address any manner of automatically communicating that a web page has been downloaded as required by claim 8. The Examiner basely asserts that combining

Zandi with Norris, Titan, and Walker et al. would have been obvious, yet the cited references fail to disclose or teach most of the limitations of claim 8.

Because all of the claim limitations recited by claim 8 are not present within the cited art, a prima facie case of obviousness within the intent of 35 U.S.C. § 103 has not been established. **Uniroyal, supra**. The rejection of claim 8 predicated upon the combination of Walker et al. in view of Titan, in further view of Norris should be reconsidered and withdrawn.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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